

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 52021
Andrew ROUSE et al. : Confirmation Number: 6988
Application No.: 09/750,320 : Group Art Unit: 2618
Filed: December 29, 2000 : Examiner: D. Nguyen
For: PROVIDING WIRELESS DEVICE ACCESS (as amended)

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Mail Stop Amendment
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants request that a Panel Review of the rejected claims in the Ninth and Final Office Action dated January 9, 2013 (hereinafter the Ninth Office Action), be performed in the above identified application.

REMARKS

CLAIMS 38-39 AND 41-44 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 2 and 3 of the Ninth Office Action, the Examiner newly rejected claims 38-39 and 41-44 based upon 35 U.S.C. § 101. The Examiner asserted that the specification does not define a storage medium as "excluding intangible media such as signals, carrier waves, propagated signals, etc." (emphasis in original). Appellants note, however, the Examiner has presented no evidence to support a finding that the term storage medium includes a transitory,

propagating, signal *per se*, which was the subject of the In re Nuijten, 500 F.3d 1346 (Fed. Cir. 2007). Reference is made to the non-precedential opinion of Ex parte Mehta (Appeal No. 2008-004853). In reversing a rejection under 35 U.S.C. § 101, the Board held the following:

We agree with Appellants (App. Br. 10-11; Reply Br. 1-3), however, that, contrary to the Examiner's contention, claims 29-42 necessarily include a storage medium since the language of independent claim 29 recites an "article comprising a storage medium...." Further, the language of independent claim 29, which recites that the storage medium stores computer-executable instructions which are readable and cause a computer to perform the listed operations, establishes the requisite structural and functional interrelationships between the computer and the stored instructions which permit the computer's functionality to be realized. *See In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994). (emphasis added)

Therefore, the Board recognized that the presence of "storage medium" within the claims renders the claims statutory under 35 U.S.C. § 101. Similarly, within Ex parte Goldberg (Appeal No. 2009-011732), the Board reversed a rejection under 35 U.S.C. § 101 to a claim reciting "[a] computer program product, comprising: a computer storage medium and an executable computer program code mechanism embedded in the computer storage medium" (emphasis added).

CLAIMS 21-22, 25-30, 32-35, 37-39, AND 42-44 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON KOBAYASHI, U.S. PATENT NO. 6,633,759, AND ULRICH ET AL., U.S. PATENT NO. 6,052,735 (HEREINAFTER ULRICH)

In the Decision on Appeal dated October 1, 2012, the Board reversed the rejections of claims 24-25, 27, 41-42, and 44. The Board then entered a new rounds of rejection as to claims 24-25, 27, 41-42, and 44. Referring specifically to the first full paragraph on page 12 of the Decision on Appeal, the Board asserted the following:

Nevertheless, presuming that information the profile contains is given patentable weight, neither the Examiner nor Appellants have identified any meanings for these

limitations other than their customary term meanings in light of the Specification, which we find does not distinguish from customary term meanings (Spec. 31:15 – 32:2; *see* App. Br. 6). Accordingly, we apply customary term meanings. As addressed *supra*, we agree with and adopt the Examiner's findings from the reproduced Ulrich's disclosures directed to a user setting "profile parameters" (Ans. 9-10; *see* Ulrich col. 14, ll. 15-19). Such profile parameters that are understood by a mobile device (*see id.*) teach and suggest the device's profile comprises a feature of the wireless client device. Without this suggestion, the parameters would not be understood by the mobile device. (emphasis added)

To be clear, the limitations at issue (i.e., claim 24) were "the profile of the wireless client device comprises one or both of at least one feature of the wireless client device or a device type of the wireless client device." Although the Board determined that Ulrich teaches or suggests "the device's profile comprises a feature of the wireless client device," the Board made no such findings regarding the claimed "a device type of the wireless client device." Each of independent claims 21, 28, 33, and 38 were amended to recite "the profile of the wireless client device includes a device type of the wireless client device," which was previously recited in claim 24.

On page 10 of the Ninth Office Action, the Examiner responded to Appellants' arguments as follows:

However, Ulrich teaches "the profile of the wireless client device includes a device type of the wireless client device" (see page 12 1st and 2nd Paragraphs of BPAI Decision of 10/01/2012; and also see Column 12 lines 57-65. (emphasis in original)

Appellants respectfully submit that the Examiner has ignored Appellants' arguments. Contrary to the Examiner's assertion, the prior Decision on Appeal made no findings that Ulrich teaches a profile that includes a device type of the wireless client device. The Board held that Ulrich teaches a feature of the wireless client device – not a device type.

To be clear, claim 24 (which was being discussed by the Board) recited the "the profile of the wireless client device comprises one or both of at least one feature of the wireless client

device or a device type of the wireless client device" (emphasis added). Because of the term "or" was used in the claim, only one of the claimed limitations (i.e., "feature of the wireless client device" or "a device type of the wireless client device") needed to be shown to establish obviousness. While the Board found that the "feature of the wireless client device" was taught by the applied prior art, the Board did not find that the claimed "a device type of the wireless client device" was taught by the prior art. Therefore, the Examiner's reliance on the Board's findings as to the claimed "a device type of the wireless client device," which was added to all of the independent claims, is misplaced.

On pages 10 and 11 of the Ninth Office Action, the Examiner then asserted the following:

the BPAI has made it very explicit that a "profile including a device type" is non-functional descriptive material that is NOT given patentable weight. (emphasis omitted)

Contrary to the Examiner's assertion the Board do not make this statement "very explicit." Instead, the Board couched the argument with the term "[a]rguably," which means that an argument could be made the claimed device type is non-functional descriptive material but that is not necessarily a winning argument. The fact that the Board was not completely sold on this argument is confirmed by the following paragraph in the Decision in which the Board wrote "presuming that information the profile contains is given patentable weight" (emphasis added).

Notwithstanding the Board's uncertainty as to the "non-functional descriptive material" argument, the Examiner wrote on page 11 that "

In support, according to the BPAI Decision, such profile parameters that are understood by a mobile device (see id.) teach and suggest the device's profile comprises a feature of the wireless client device. Without this suggestion, the parameters would not be understood by the mobile device. (emphasis omitted)

Of note, the Examiner's own analysis confirms that information contained in the profile is functional since it permits the parameters to be understood by the mobile device (i.e., the claimed wireless client device).

Additionally, Federal Circuit case law does not permit the Examiner to ignore claim limitations. "The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art." In re Lowry, 32 F.3d 1579, 1582 (Fed. Cir. 1994) (citing In re Gulack, 703 F.2d 1381, 1385 (Fed. Cir. 1983)). The claimed "device type" is a data structure, and with regard to data structures the Federal Circuit also stated the following:

In short, Lowry's data structures are physical entities that provide increased efficiency in computer operation. They are not analogous to printed matter. The Board is not at liberty to ignore such limitations.

Thus, the Examiner cannot ignore the claimed "a device type of the wireless client device," which was added to all of the independent claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 122158, and please credit any excess fees to such deposit account.

Date: April 9, 2013

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

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CUSTOMER NUMBER 52021